

Application No. 10/669,581  
Amendment dated September 13, 2005  
Reply to Office Action of May 17, 2005

## **REMARKS**

### **Status Of Application**

Claims 1-31 are pending in the application; the status of the claims is as follows:

Claims 1-21, 27 and 28 are withdrawn from further consideration pursuant to 37 C.F.R. § 1.142(b) as being drawn to a nonelected Invention and Species, there being no allowable generic or linking claim.

Claims 24 and 25 are rejected under the second paragraph of 35 U.S.C. § 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 22, 30 and 31 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 3,650,210 to Archer ("Archer") in view of U.S. Patent No. 5,156,384 to Donahue ("Donahue").

Claim 23 is rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Archer and Donahue as applied to claims 22, 30 and 31 above, and further in view of U.S. Patent No. 2,430,720 to Kline ("Kline").

Claims 24 and 25 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Archer and Donahue as applied to claims 22, 30 and 31 above, and further in view of U.S. Patent No. 5,586,479 to Roy et al. ("Roy").

Claim 26 is rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Archer, Donahue and Kline as applied to claims 22, 30 and 31 above, and further in view of Roy.

Application No. 10/669,581  
Amendment dated September 13, 2005  
Reply to Office Action of May 17, 2005

Claim 29 is rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Archer and Donahue as applied to claims 22, 30 and 31 above, and further in view of U.S. Patent No. D462,965 to Pentz ("Pentz").

#### **Claim Amendments**

Claim 22 has been amended to more particularly point out and distinctly claim the invention. Claims 24 and 29 have been amended to correct formal errors. These changes do not introduce any new matter.

#### **35 U.S.C. § 112 Rejection**

The rejection of claims 24 and 25 under the second paragraph of 35 U.S.C. § 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant(s) regard as the invention, is respectfully traversed based on the following.

Claim 24 was erroneously dependent upon claim 22 rather than claim 23. Support for "said first conveyor" is included in claim 23. Claim 24 has been amended to depend from claim 23.

Accordingly, it is respectfully requested that the rejection of claims 24 and 25 under the second paragraph of 35 U.S.C. § 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant(s) regard as the invention, be reconsidered and withdrawn.

#### **35 U.S.C. § 103(a) Rejections**

The rejection of claims 22, 30 and 31 under 35 U.S.C. § 103(a), as being unpatentable over the Archer patent in view of Donahue, is respectfully traversed based on the following.

Application No. 10/669,581  
Amendment dated September 13, 2005  
Reply to Office Action of May 17, 2005

Archer shows a credit card security system where a segment 16 can be separated from the credit card 10 and stored in a different place by the user (col. 2, lines 33-39). The segment is created by a punch or die cutter. The cutting is such that webs 18 hold the segment in place. The segment is then separated from the card by the user (col. 2, lines 20-24). In fact, the user may leave the segment intact (col. 2, lines 28-32).

Donahue shows a system for producing paper inserts (30, 32, 34) that includes a conveyor 20 for moving the inserts in process.

In contrast to the cited references, claim 22 includes:

A method for cutting financial cards from a first configuration having a first periphery to a second configuration having a second periphery, said method comprising:

- (a) supplying a plurality of financial cards having said first configuration individually to a cutting station;
- (b) cutting said financial cards to said second configuration having said second periphery at said cutting station; ...

Archer does not show or suggest creating a separate card, but rather provides a segment that can be removed by the user. The result of the cutting or stamping process in Archer produces a card having the identical periphery of the card prior to processing. Donahue shows a process of separating paper inserts. Neither reference, alone or in combination, shows or suggests a creating a "second configuration having a second periphery" from cards of a "first configuration having a first periphery." To support a *prima facie* case for obviousness, the references must show or suggest every limitation of the claim. MPEP §2143.03. Therefore, claim 22 is not obvious over the cited references. Claims 30 and 31 are dependent upon claim 22 and thus include every limitation of claim 22. Therefore, claims 30 and 31 are also not obvious over the cited references.

Accordingly, it is respectfully requested that the rejection of claims 22, 30 and 31 under 35 U.S.C. § 103(a) as being unpatentable over the Archer patent in view of Donahue, be reconsidered and withdrawn.

Application No. 10/669,581  
Amendment dated September 13, 2005  
Reply to Office Action of May 17, 2005

The rejection of claim 23 under 35 U.S.C. § 103(a), as being unpatentable over the combination of Archer and Donahue as applied to claims 22, 30 and 31 above, and further in view of Kline et al., is respectfully traversed based on the following.

Kline shows a plurality of spaced nests. Claim 23 is dependent upon claim 22, and thus includes every limitation of claim 22. As noted above, Archer and Donahue do not show or suggest a creating a "second configuration having a second periphery" from cards of a "first configuration having a first periphery." Kline also does not show or suggest this limitation, alone or in combination with the other references. Therefore, the cited references do not support a *prima facie* case for obviousness of claim 23.

Accordingly, it is respectfully requested that the rejection of claim 23 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Archer and Donahue as applied to claims 22, 30 and 31 above, and further in view of Kline et al., be reconsidered and withdrawn.

The rejection of claims 24 and 25 under 35 U.S.C. § 103(a), as being unpatentable over the combination of Archer and Donahue as applied to claims 22, 30 and 31 above, and further in view of Roy et al., is respectfully traversed based on the following.

Roy includes photoelectric sensors 58A and 58B to detect alignment of images 50 on a receiving sheet 75. Claims 24 and 25 are dependent upon claim 22, and thus include every limitation of claim 22. As noted above, Archer and Donahue do not show or suggest a creating a "second configuration having a second periphery" from cards of a "first configuration having a first periphery." Roy also does not show or suggest this limitation, alone or in combination with the other references. Therefore, the cited references do not support a *prima facie* case for obviousness of claims 24 and 25.

Accordingly, it is respectfully requested that the rejection of claims 24 and 25 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Archer and

Application No. 10/669,581  
Amendment dated September 13, 2005  
Reply to Office Action of May 17, 2005

Donahue as applied to claims 22, 30 and 31 above, and further in view of Roy at al., be reconsidered and withdrawn.

The rejection of claim 26 under 35 U.S.C. § 103(a), as being unpatentable over the combination of Archer, Donahue and Kline as applied to claims 22, 30 and 31 above, and further in view of Roy at al., is respectfully traversed based on the following.

Claim 26 is dependent upon claim 22, and thus include every limitation of claim 22. As noted above, Archer, Roy, Kline and Donahue, alone or in combination, do not show or suggest a creating a "second configuration having a second periphery" from cards of a "first configuration having a first periphery. Therefore, the cited references do not support a *prima facie* case for obviousness of claim 26.

Accordingly, it is respectfully requested that the rejection of claim 26 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Archer, Donahue and Kline as applied to claims 22, 30 and 31 above, and further in view of Roy at al., be reconsidered and withdrawn.

The rejection of claim 29 under 35 U.S.C. § 103(a), as being unpatentable over the combination of Archer and Donahue as applied to claims 22, 30 and 31 above, and further in view of Pentz, is respectfully traversed based on the following.

Pentz shows a data card having a roughly square shape. Claim 29 is dependent upon claim 22, and thus includes every limitation of claim 22. As noted above, Archer and Donahue do not show or suggest a creating a "second configuration having a second periphery" from cards of a "first configuration having a first periphery." Pentz also does not show or suggest this limitation, alone or in combination with the other references. Therefore, the cited references do not support a *prima facie* case for obviousness of claim 29.

Application No. 10/669,581  
Amendment dated September 13, 2005  
Reply to Office Action of May 17, 2005

Accordingly, it is respectfully requested that the rejection of claims 24 and 25 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Archer and Donahue as applied to claims 22, 30 and 31 above, and further in view of Pentz, be reconsidered and withdrawn.

### **CONCLUSION**

Wherefore, in view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and an early reconsideration and a Notice of Allowance are earnestly solicited.

This Amendment does not increase the number of independent claims, does not increase the total number of claims, and does not present any multiple dependency claims. Accordingly, no fee based on the number or type of claims is currently due. However, if a fee, other than the issue fee, is due, please charge this fee to Sidley Austin Brown & Wood LLP's Deposit Account No. 18-1260.

Any fee required by this document other than the issue fee, and not submitted herewith should be charged to Sidley Austin Brown & Wood LLP's Deposit Account No. 18-1260. Any refund should be credited to the same account.


If an extension of time is required to enable this document to be timely filed and there is no separate Petition for Extension of Time filed herewith, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) for a period of time sufficient to enable this document to be timely filed.

Application No. 10/669,581  
Amendment dated September 13, 2005  
Reply to Office Action of May 17, 2005

Any other fee required for such Petition for Extension of Time and any other fee required by this document pursuant to 37 C.F.R. §§ 1.16 and 1.17, other than the issue fee, and not submitted herewith should be charged to Sidley Austin Brown & Wood LLP's Deposit Account No. 18-1260. Any refund should be credited to the same account.

Respectfully submitted,

By: \_\_\_\_\_

  
Douglas A. Sorensen  
Registration No. 31,570  
Attorney for Applicants

DAS/fis:jkk  
SIDLEY AUSTIN BROWN & WOOD LLP  
717 N. Harwood, Suite 3400  
Dallas, Texas 75201  
Direct: (214) 981-3482  
Main: (214) 981-3300  
Facsimile: (214) 981-3400  
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